UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte STEPHEN J. BOIES, SAMUEL DINKIN, PAUL ANDREW MOSKOWITZ and PHILIP SHI-LUNG YU

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Appeal No. 2005-2081
Application No. 09/628,233

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ON BRIEF

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Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-12, 18-31, 37, 38, 46, 47, 50 and 51, which constitute all the claims pending in this application.

The disclosed invention pertains to the field of performing searches on a network such as the Internet. The invention utilizes the services of a portal server which acts as a search interface and intermediary between users and content

providers. The portal server stores information identifying registered content providers, information identifying indexed content, and information identifying portal tagging standards. One feature of the invention is that each content provider can establish and use its own tagging standard.

Representative claim 1 is reproduced as follows:

> 1. A method of decentralized e-commerce, comprising:
>
> receiving a search request from a user to search content stored on at least one content server, wherein the content includes provider tags identifying each of at least one content field within the content, and wherein the search request includes at least one search term associated with at least one portal tag, the portal tag being part of a portal tagging standard and identifying a type of data within content to be searched;
>
> identifying the provider tag corresponding to the portal tag using a cross-reference of portal tags corresponding to provider tags; and
>
> comparing the search term with a content field tagged with a provider tag corresponding to the portal tag associated with the search term.

The examiner relies on the following references:

Friedland et al. (Friedland)	6,449,601	Sep. 10, 2002 (filed Dec. 30, 1998)
Anderson et al. (Anderson)	6,510,434	Jan. 31, 2003 (filed Dec. 29, 1999)

Claims 1-12, 18-31, 37, 38, 46, 47, 50 and 51 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Friedland in view of Anderson.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to

support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of

the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived (see 37 CFR § 41.37(c)(1)(vii)(2004)).

Appellants have indicated that for purposes of this appeal the claims will stand or fall together in the following three groups: Group I has claims 1-12, 20-31 and 47, Group II has claims 18, 19, 37, 38, 46 and 50, and Group III has claim 51 (brief, page 5). Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against claims 1, 18 and 51 as representative of all the claims on appeal.

The examiner has indicated how the claimed invention is believed to be unpatentable over the teachings of Friedland and Anderson (answer, pages 4-5). With respect to independent claim 1, appellants argue that Friedland and Anderson fail to teach either (1) using both portal tags and provider tags, (2) identifying a provider tag corresponding to a portal tag using a cross-reference of portal tags corresponding to provider tags, or (3) comparing a search term with a content field flagged with a provider tag corresponding to the portal tag associated with the item. Appellants note that the examiner's rejection fails to address any feature of claim 1. Appellants argue that the tagging in Anderson does not teach the use of provider tags and portal tags as claimed. As such, appellants argue that there is no cross-reference between two different tagging schemes. Appellants also argue that there is no motivation for combining the teachings of Friedland and Anderson (brief, pages 5-12).

The examiner responds that both Friedland and Anderson discuss categories and e-commerce. The examiner asserts that Anderson teaches a dual tagging structure in which the domain tag is functionally equivalent to the claimed portal tag, and the category tag is functionally equivalent to the claimed provider tag. The examiner essentially asserts that the applied

references do the same thing as appellants' claimed invention. Finally, the examiner responds that the motivation to combine the references is to search in the most efficient manner and supporting multiple databases (answer, pages 5-17).

Appellants respond that Anderson teaches a single tagging structure because the domain and category tags are not tagging standards but only tags within a single tagging standard. Appellants assert that Anderson does not teach the use of both portal tags and provider tags as claimed. Appellants also reiterate their position that the examiner has failed to address the specific language of the claims (reply brief).

We will not sustain the examiner's rejection of independent claim 1 for essentially the reasons argued by appellants in the briefs. We agree with appellants that the examiner's rejection fails to specifically address the language of the claims. The examiner has also ignored the meaning of a provider tag and a portal tag. The domain and category tags of Anderson are not equivalent to provider tags and portal tags as claimed. We can find no teaching in the applied prior art which relates a tag which has been provided by a content provider (a provider tag) to a tag that is associated with a portal (a portal tag). Since the examiner has failed to properly interpret the

claimed provider tags and portal tags, the rejection fails to establish a prima facie case of obviousness.

Since all the claims on appeal recite identifying the relationship between a provider tag and a portal tag, and since the examiner has failed to properly interpret these terms for reasons discussed above, we do not sustain the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-12, 18-31, 37, 38, 46, 47, 50 and 51 is reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)	
ERROL A. KRASS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JERRY SMITH Administrative Patent Judge	)	

JS:hh

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